

REMARKS

I. Supplemental Information Disclosure Statement

This Amendment is being filed concurrently with a Supplemental Information Disclosure Statement citing the document U.S. Patent No. 6,068,693. Applicants respectfully request that the Examiner consider this patent and indicate that it was considered making the appropriate notation on the SB-08 Form attached to the Supplemental Information Disclosure Statement.

II. Status of the Claims

Claims 1-10 and 12-39 are pending. Without prejudice or disclaimer, claim 11 has been canceled and claims 12, 15, 16, 22, 26, 35, and 37 have been amended. Claim 12 has been amended to become an independent claim. Claim 16 has been amended to become an independent claim and incorporate the limitations of claim 11. Consequently, claim 11 has been canceled. Claim 22 has been amended to depend from claim 16. Claims 15, 26 and 37 have been amended to correct claim dependency. Claim 35 has been amended to correct typographical errors.

Support for these amendments can be found in the specification and claims as-filed. Accordingly, no new matter has been added.

Applicants acknowledge, with appreciation, the Examiner's indication of allowable subject matter in claims 11-15, 17-21, and 26. Applicants also acknowledge that claims 6, 7, 25, 27, and 36 would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims. Applicants

believe all claims to be patentable, and therefore have kept claims 6, 7, 25, 27, and 36 as dependent claims.

III. Rejections under 35 U.S.C. § 103(a)

A. Claims 1-3, 8-10, 16, 22, 23, and 28-34

The Examiner rejects claims 1-3, 8-10, 16, 22, 23, and 28-34 under 35 U.S.C. § 103(a) as allegedly "being unpatentable over" U.S. Patent No. 5,685,900 to Yuan et al. ("Yuan") in view of U.S. Patent No. 5,454,865 to Ginn et al. ("Ginn"). Office Action at 2. In particular, the Examiner asserts that Yuan "disclose[s] a higher brightness clay used for coating paper of at least 93," (citing Yuan at col. 4, lines 8-12) and "titania contamination of 0.5 to 3.0 weight %" (citing Yuan at col. 3, lines 46-47). *Id.* The Examiner further asserts that Ginn "disclose[s] a method of refining both fine and coarse crudes by grinding, classifying, flocculation and bleaching as shown in Figure 1." *Id.*

Thus the Examiner concludes "[i]t would have been obvious to one of ordinary skill in the art to use the method of Ginn, et al. with the higher brightness particulate clay of Yuan, et al. to obtain the claimed materials." *Id.* at 3. The Examiner supports her conclusion merely by stating that a "prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities." *Id.* Applicants respectfully traverse this rejection for at least the reason that the Examiner has not established a prima facie showing of obviousness.

In order to establish a prima facie showing of obviousness, the Examiner must, among other things, demonstrate that all of the elements of the presently rejected claims are taught or suggested by Yuan in view of Ginn, as required by M.P.E.P. § 2143. In the present application, independent claims 1 and 28 recite, in relevant part,

that the claimed hydrous kaolin pigment have "a steepness ($d_{30}/d_{70} \times 100$) of at least about 39." The Examiner has not shown and cannot show that Yuan and/or Ginn teach or suggest the "steepness" as-claimed, as both are silent with respect to "steepness."

Moreover, independent claim 28 recites, in relevant part, a hydrous kaolin pigment with "a titania concentration of less than or equal to about 0.40% by weight of the pigment on a dry basis." The Examiner has not shown and cannot show that Yuan and/or Ginn teach or suggest the "titania concentration" as claimed. Example 1 of Yuan teaches an end product with a "titania content of 0.47%" (Yuan at col. 5, line 63) which is greater than the claimed content of "less than or equal to about 0.40%." Further, Ginn does not discuss titania content at all in its kaolin products.

It is well-established that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art," in order to establish a prima facie case of obviousness. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Despite this requirement, the Examiner has clearly not considered all claimed elements of the present disclosure. Thus, the Examiner's statement that a "prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities" is not accurate in view of the present facts, and thus bears no relevance to the claimed invention. For at least these reasons, the Examiner has not fulfilled all of the requirements of M.P.E.P. § 2143. Accordingly, this rejection is in error and Applicants respectfully request its withdrawal.

B. Claims 1-5, 24, 35, and 37-39

The Examiner rejects claims 1-5, 24, 35, and 37-39 under 35 U.S.C. § 103(a) as allegedly "being unpatentable over" U.S. Patent No. 6,893,536 to Ilmonen et al.

("Ilmonen"). Office Action at 3. Specifically, the Examiner asserts that Ilmonen "disclose[s] a process and coating composition for coating a paper web wherein the coating pigment comprises kaolin (col. 3, l. 60-61) which is bleached with peroxide (col. 6, l. 61-67) and has a brightness of 94.7% (col. 8, l. 60-63)." *Id.*

Applicants respectfully traverse this rejection as the Examiner has not established a prima facie showing of obviousness. In fact, the Examiner does not even bother to make a conclusory statement to support her contention of obviousness. As discussed above, under M.P.E.P. § 2143, a prima facie showing of obviousness requires the Examiner to at least demonstrate that all of the elements of the presently rejected claims are taught or suggested by Ilmonen.

First, Ilmonen does not teach or disclose the claimed steepness value recited in claim 1 of the claimed invention. Ilmonen does not discuss steepness at all.

Second, Ilmonen does not even teach a hydrous kaolin pigment as claimed, but rather teaches a pigment with high concentrations of precipitated calcium carbonate (PCC) and gypsum. In fact, Ilmonen teaches that "[w]ith mixtures of calcium carbonate and gypsum, . . . there are obtained simultaneously a sufficient gloss and smoothness as well as a brightness and opacity **better than with PCC-kaolin pastes.**" See Ilmonen at Abstract (emphasis added). Thus, Ilmonen actually teaches away from the claimed invention, and thus does not render the claimed hydrous kaolin pigments obvious. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must also be considered. See *Bausch & Lomb, Inc. v. Barnes Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Moreover, any attempt to cure the teaching away would be fundamentally

improper as it would destroy the inventive nature of Ilmonen. See *In re Laskowski*, 871 F.2d 115, 10 USPQ 2d 1397 (Fed. Cir. 1989) (holding that it is improper to combine references if their combination would result in the destruction of the intended operation or if a reference teaches away from the claimed invention).

Accordingly, for at least the foregoing reasons, this rejection is in error and Applicants respectfully request its withdrawal.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is invited to contact Applicants' undersigned counsel at 202-408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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